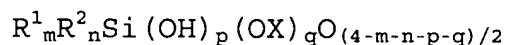


**REMARKS****Status of the claims:**

With the above amendments, claim 2 has been canceled and claim 11 has been added. Claims 9 and 10 have been withdrawn from consideration by a prior restriction requirement. Thus, claims 1 and 3-11 are pending with claims 1, 3-8 and 11 ready for further action on the merits. No new matter has been added by way of the above amendments. Support for claim 11 can be found at page 2, line 29 to page 3, line 23 and at page 22, lines 10-12 and in Example 2. Entry of the amendments and reconsideration is respectfully requested in light of the following remarks.

**Rejections under 35 USC §102**

Claims 1-8 are rejected under 35 USC §102(b) as being anticipated by Yamaya '355 (EP 0 841 355 A2). The Examiner asserts that Yamaya '355 discloses an article comprising a paper substrate (page 15, line 39) coated with an emulsion composition comprising 100 parts by weight of a water-insoluble silanol group bearing silicone resin of the formula



wherein R1 is an unsubstituted monovalent hydrocarbon group (preferably of 1-10 carbon atoms), R2 is a substituted monovalent hydrocarbon group (preferably of 1-10 carbon atoms),

X is a monovalent hydrocarbon group of 1 to 6 carbon atoms, and letters m, n, p, and q satisfy the following formulas:  $0.5 \leq m \leq 1.8$ ,  $0 \leq n \leq 1.0$ ,  $0 < p \leq 1.5$ ,  $0 \leq q \leq 0.5$ ,  $0.5 \leq m+n \leq 1.8$ ,  $0 < p+q \leq 1.5$ . The composition also contains 10 to 1,000 parts by weight of a radical polymerizable vinyl monomer. The Examiner asserts that at page 15, lines 38-41, there is disclosed applying the emulsion to paper.

Applicants traverse.

**Removal of the Rejection over Yamaya '355**

Applicants submit that the Examiner has inadvertently misconstrued the term "coated at least in part upon paper making" in claim 1. This term refers to applying the emulsion to paper while the paper is being made. Yamaya '355 only discloses applying an emulsion to paper that has already been made. Applicants recognize that "coated at least in part upon paper making" is a process limitation and this limitation appears in product claims but assert that this process limitation should be read into the product claims. It is well-settled that process limitations should be read into product claims when it results in a product that has distinctive structural characteristics from the final product. See *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979). The

instant invention results in a product that is structurally distinctive from the product in Yamaya '355 for the following reasons.

Yamaya '355 adds an emulsion to the paper that is already made. This results in a paper that is physically different from the paper of the instantly claimed invention. The instant invention claims an emulsion that is added to the paper, at least in part, during the paper-making process. The physical differences that result are apparent when one considers that Yamaya '355 discloses a paper that is only treated on the surface of the paper, whereas the paper of the instant invention contains cellulose fibers that are completely coated with the composition of the instant invention because the emulsion is added at least in part during the paper-making process. These physical differences manifest themselves in differences in the properties of the two papers. As disclosed in the instant invention, if the emulsion is added during the paper-making process, the ink jet paper that results is minimized in deformation or stretching and contraction and affords the paper with a high color development density as well as a high color gloss and sharp hue. As disclosed in Yamaya '355, if the emulsion is added after the paper is made, the resulting paper does not have the advantageous minimization of deformation or stretching and contraction and also results in a paper that does

not have the high color development density as well as a high color gloss and sharp hue.

Thus, the instant invention cannot be anticipated by the disclosure of Yamaya '355 because Yamaya '355 fails to disclose the elements of the instant invention. Yamaya '355 does not disclose adding an emulsion at least in part during the paper-making step. This step, as enumerated above, results in a paper that is physically different from the paper of Yamaya '355.

Moreover, Yamaya '355 cannot render obvious the instant invention because the instant invention discloses features in the paper that are unexpectedly advantageous over the disclosure of Yamaya '355. In particular, the paper of Yamaya '355 does not have the advantageous minimization of deformation or contraction in the paper and is inferior in color development density as well as gloss and hue. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg.


No. 50,990), in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

  
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